

RECEIVED

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

NOV 20 2002
TC 2800 MAIL ROOM#9 / Resps.
+ Request
for Interview

11-21-02

L. Spruell

In re Application of:

Galyn A. Schulz

U.S. Serial No. 09/686,210

Filed: October 11, 2000

Docket No. 2107 (FJ-98-4)

For: APPARATUS AND METHODOLOGY
FOR EMBOSSED FIBROUS WEBS
CONTAINING CONTAMINANTS

Examiner: R.L. Yan

Group Art Unit: 2854

VIA FACSIMILE -
AFTER FINAL
703-308-5841Assistant Commissioner for Patents
Washington, D.C. 20231

OFFICIAL

FAX RECEIVED

NOV 19 2002

GROUP 1700

RESPONSE AND REQUEST FOR PERSONAL INTERVIEW

Sir:

This letter is responsive to the Official Action of August 30, 2002 finally rejecting Claims 1-16 in the above-noted case.

In the Office Action of August 30, 2002, all of the claims were finally rejected on the basis of obviousness, only, over United States Patent No. 5,269,983 of *Schulz* (inventor herein) in view of United States Patent No. 5,215,617 to *Grupe*. The Examiner acknowledged, however, that neither reference discusses the problems associated with processing recycled fiber with contaminants as is claimed in this case:

Even though neither *Schulz* nor *Grupe* discusses the problems associated with processing recycled fiber, one of ordinary skill in the art would have known that

the embossing machine as taught by *Schulz* and *Grupe* is well capable of processing fibrous web containing recycled pulp without suffering excessive wear due to the contaminants in the pulp simply because this embossing machine having the steel and rubber embossing roller pair with their respective Shore A hardness would tolerate the contaminants in the recycled pulp the same way as would the embossing machine of the present invention.

August 30 Office Action, pp. 3-4

The present invention is specifically directed to a method of processing recycle fiber containing contaminants (including stickies in many claims) and is thus believed patentable over the cited references which do not suggest the damage problem solved by the invention. The MPEP specifically provides that "ordinary skill in the art" cannot be a sufficient basis to reject claims.

FACT THAT THE CLAIMED INVENTION IS WITHIN THE CAPABILITIES OF ONE OF ORDINARY SKILL IN THE ART IS NOT SUFFICIENT BY ITSELF TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS

A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000) (Court reversed obviousness rejection involving technologically simple concept because there was no finding as to the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.).

MPEP §2143.01, 4th heading

Moreover, the Examiner's conclusion is at odds with the *Declaration* filed June 27, 2002 by one of skill in the art that the invention showed surprising resistance to damage:

7. That such objects fed to a conventional embossing nip would cause extensive damage to matched embossing rolls, a steel/steel matched set, for example; **however, it was surprisingly found that neither paper clips nor coins damaged the embossing rollers when the method of the invention of the above-noted patent application was employed.** Following is an excerpt from a research report detailing operation of the method of the invention of the above-noted patent application:

As part of the trial items such as a paper clip, a dime, and wadded paper were passed through the nip of the 100/60 durometer sleeves. The items were taped to the emboss roll and ran through the emboss nip five times. The emboss sleeves were examined with a 40X microscope and no damage could be detected on either the 100 durometer female sleeve or the 60 durometer male sleeve. The emboss gap was set at 26 mils which was the emboss gap required to achieve the targeted 1-ply tissue attributes. Also during the set up of the 100/60 durometer emboss sleeves there were some set up errors made, which results in the rolls being run mismatched at a supposed 0.010" emboss gap. Neither the 100 durometer female sleeve nor the 60 durometer male sleeve was damaged.

8. That despite his more than twenty-five (25) years of experience with embossing, he found it surprising that the method of the invention could be employed to withstand contaminants such as coins fed to the nip without damage to the embossing rollers. Such damage is difficult (as well as expensive) to repair and leads to significant down time of expensive machinery.

Declaration of Galyn Schulz of June 27, 2002, ¶7-8

In view of the above, it is believed this case is entitled to patent protection. Undersigned Counsel will call to arrange a personal interview.

Respectfully submitted,



Michael W. Ferrell
Attorney for Applicants
Reg. No. 31,158

Ferrells, PLLC
P.O. Box 312
Clifton, Virginia 20124-1706
Telephone: 703-266-3000
Facsimile: 703-266-6000
November 19, 2002

OFFICIAL
FAX RECEIVED
NOV 19 2002
GROUP 1700

CERTIFICATE OF MAILING BY FACSIMILE (37 CFR 1.8)

Docket No.

Applicant(s): *Galyn A. Schulz*

2107 (FJ-98-4)

Serial No.
09/686,210Filing Date
October 11, 2000Examiner
R.L. YanGroup Art Unit
2854Invention: APPARATUS AND METHODOLOGY FOR EMBOSsing FIBROUS WEBS
CONTAINING CONTAMINANTS

I hereby certify that this *Response and Request for Personal Interview* is being facsimiled to Examiner R.L. Yan (Group 2854) at 703-308-5841 and addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231 on November 19, 2002.

Carol R. Maddaloni

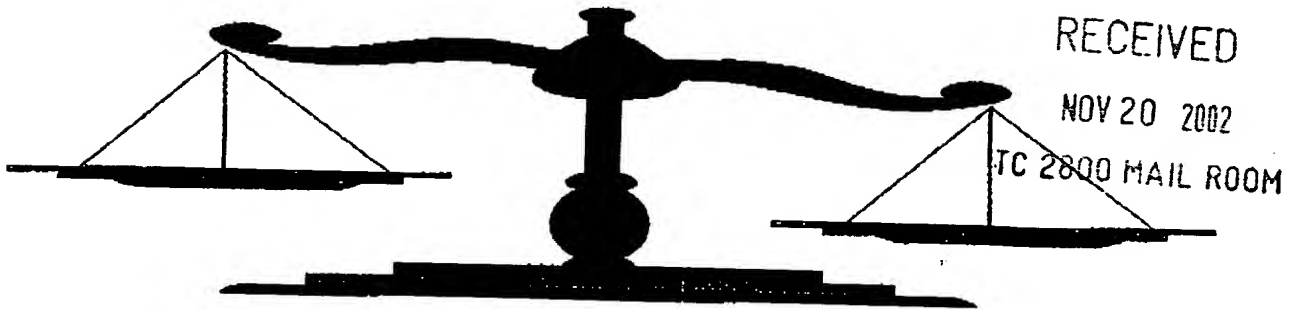
(Typed or Printed Name of Person Faxing Correspondence)



(Signature of Person Faxing Correspondence)

Note: Each paper must have its own Certificate of Mailing.

OFFICIAL
FAX RECEIVED
NOV 19 2002
GROUP 1700



FERRELLS, PLLC
P.O. Box 312
Clifton, Virginia 20124-1706
TELEPHONE - (703) 266-3000
FACSIMILE - (703) 266-6000

PLEASE DELIVER THE FOLLOWING FACSIMILE TRANSMISSION TO:

NAME: Examiner R.L. Yan / Group 2854

LOCATION: USPTO

RECEIVING FAX NO.: 703-872-9310 (Technology Center - after final)

FROM: Michael W. Ferrell

NO. OF PAGES, INCLUDING COVER SHEET: 5

DATE AND TIME: November 19, 2002

COPIES TO: _____

MESSAGE: _____

OFFICIAL

FAX RECEIVED
NOV 19 2002
GROUP 1700